



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,597	06/12/2001	Nobuhide Matsuda	F-7030	3595

7590 01/29/2004
Jordan and Hamburg LLP
122 East 42nd Street
New York, NY 10168

EXAMINER

RODRIGUEZ, GLENDA P

ART UNIT PAPER NUMBER

2651

DATE MAILED: 01/29/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,597

Applicant(s)

MATSUDA ET AL.

Examiner

Glenda P. Rodriguez

Art Unit

2651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (Fig. 4). Admitted Prior Art discloses a magnetic transfer apparatus including members for performing magnetic transfer of signals from one medium to another, comprising:

A base plate on which the members are placed (Fig. 4);

A casing on the plate covering the members entirely (Fig. 4, Element 10);

And a plurality of particle measurement device fixed in the base plate (Fig. 4, Element 16. Admitted Prior Art teaches one particle device being used in the base plate.

It is known to use more than one to make a plurality and more specific measurements in the medium.).

Admitted Prior Art fail to teach a plurality of particle measurement devices in the base plate. It would have been obvious to a person of ordinary skill in the art to add a plurality of particle of particle measurement devices in order to monitor the particles

Art Unit: 2651

found in the base plate. Although the reference did not disclose a plurality of detectors, the detectors are merely a duplication of parts and/or functions, which have little patentable significance unless a new and unexpected result is produced. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art. Admitted Prior Art teaches all the limitations of Claim 1. Admitted Prior Art fail to teach wherein the particle measurement devices are disposed respectively near each of selected ones of the members. It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to place the measurement devices in those specific places, in order to make more accurate measurements while the medium is performing its normal operations.

4. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Sugimoto et al. (US Patent No. 5, 824, 920).

Regarding Claim 3, Admitted Prior art teach all the limitations of Claim 1. Admitted Prior Art also teach the use of a suction port (Fig. 4, Element 16). Admitted Prior Art fail to teach a particle counter for measuring particles present in air drawn off from the casing through the suction port, and a tube for connecting the suction port to the particle counter. However, this feature is well known in the art as disclosed by Sugimoto et al., wherein it teaches a particle counter for measuring particles present in air drawn off from the casing through the suction port, and a tube for connecting the suction port to the particle counter (Pat. No. 5, 824, 920; Col. 9, Lines 10-19 and 22-41). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made,

Art Unit: 2651

to modify Admitted Prior Art to add a suction port and a particle counter in order to know the conditions of the medium during the transfer of magnetic data.

Regarding Claim 4, Admitted Prior Art and Sugimoto et al. teach all the limitations of Claim 3. Admitted Prior Art fail to teach wherein the particle measurement devices are disposed respectively near each of selected ones of the members. It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to place the measurement devices in those specific places, in order to make more accurate measurements while the medium is performing its normal operations.

Regarding Claim 5, Admitted Prior Art teaches a particle monitoring method that performs measuring articles within the magnetic transfer apparatus by a plurality of particle measurement devices disposed at a plurality of measurement locations in the magnetic transfer apparatus and specifying a source of particles (Fig. 4, Element 16. Admitted Prior Art teaches one particle device being used in the base plate. It would have been obvious to a person of ordinary skill in the art to use more than one to make a plurality and more specific measurements throughout.). Admitted Prior Art fail to teach that the measurement devices determine a number of particles measure in a time series. However, this feature is known in the art as disclosed by Sugimoto, wherein it teach a particle counter that controls the amount or particles in a magnetic medium throughout the time of use of the medium and evaluates the cleanliness in the magnetic transfer apparatus (Pat. No. 5, 824, 920; Col. 9, Lines 10-19 and 22-41. Sugimoto et al. teach a magnetic medium that has a suction port and a particle counter that by the amount of particles being found in the medium, controls the air flow in the medium to

Art Unit: 2651

then be able to make the medium sufficiently clean for it to operate efficiently.). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to modify Admitted Prior Art's invention in order to make the medium more efficient to monitor dust particles in the magnetic transfer apparatus and to ensure that all operations are not spoiled by dust or any other particles that could infiltrate the medium. Admitted Prior Art fail to teach a plurality of particle measurement devices in the base plate. It would have been obvious to a person of ordinary skill in the art to add a plurality of particle of particle measurement devices in order to monitor the particles found in the base plate. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regarding Claim 6, Admitted Prior Art and Sugimoto et al. teach all the limitations of Claim 5. Sugimoto et al. wherein it teach a particle counter that controls the amount or particles in a magnetic medium throughout the time of use of the medium and evaluates the cleanliness in the magnetic transfer apparatus (Pat. No. 5, 824, 920; Col. 9, Lines 10-19 and 22-41. Sugimoto et al. teach a magnetic medium that has a suction port and a particle counter that by monitoring the amount of particles (that amount could obviously also be a mean) being found in the medium by the suction port, it controls the air flow in the medium to then be able to make the medium sufficiently clean for it to operate efficiently.). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to modify Admitted Prior Art's invention in order to make the medium more efficient to monitor dust particles in the magnetic transfer apparatus and to ensure that all operations are not spoiled by dust or any other particles that could infiltrate the medium.

Allowable Subject Matter

5. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments with respect to claim 1-10 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remarks cite that Admitted Prior Art fails to disclose a plurality of particle measurement devices. However, it would have been obvious to a person of ordinary skill in art to add a plurality of particle measurement devices in order to more effectively monitor the particles in the base plate. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Although the reference did not disclose a plurality of detector, it is held that mere duplication of parts and/or functions has no patentable significance unless a new and unexpected result is produced.). See also Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps. See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).


Art Unit: 2651

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenda P. Rodriguez whose telephone number is (703) 305-8411. The examiner can normally be reached on Monday thru Thursday: 7:00-5:00; alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703)308-4825. The fax phone number for the organization where this application or proceeding is assigned is (703)308-6743.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.


gpr
January 15, 2004.


DAVID HUDSPETH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600